


<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>05452/002002</b>	
	Application Number <b>09/658,387-Conf. #3461</b>	Filed <b>September 8, 2000</b>	
	First Named Inventor <b>Aureliano Tan, Jr.</b>		
	Art Unit <b>2135</b>	Examiner <b>P. W. Klimach</b>	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 60%;"> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>48,885</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> </div> <div style="width: 35%; text-align: center;">   <hr style="border: 0; border-top: 1px solid black; margin: 5px 0;"/> Signature  <hr style="border: 0; border-top: 1px solid black; margin: 5px 0;"/> <b>T. Chyau Liang, Ph.D.</b>  Typed or printed name  <hr style="border: 0; border-top: 1px solid black; margin: 5px 0;"/> <b>(713) 228-8600</b>  Telephone number  <hr style="border: 0; border-top: 1px solid black; margin: 5px 0;"/> <b>September 25, 2007</b>  Date </div> </div>			
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Aureliano Tan, Jr.  
Application No.: 09/658,387  
Filed: September 8, 2000  
For: DIGITAL IDENTITY DEVICE

Confirmation No.: 3461  
Art Unit: 2135  
Examiner: P. W. Klimach

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Claims 1, 6, 8, 9, 59, 69, and 72

Claims 1, 6, 8, 9, and 69-72 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,623,637 ("Jones") in view of U.S. Patent No. 5,689,560 ("Cooper") and an article entitled "The Trustworthy Digital Camera: Restoring Credibility To the Photographic Image" ("Friedman"). Applicant asserts that the Examiner has failed to establish a *prima facie* case of obviousness for at least the following reasons.

*(i) Cooper fails to teach a microprocessor identity*

Independent claims 1, 34, and 73 require that the "microprocessor identity uniquely identif[ies] the microprocessor." The Examiner has asserted that Cooper teaches a machine identity, which is equivalent to a microprocessor identity. See Office Action mailed May 25, 2007, p. 4. The Applicant respectfully disagrees. Specifically, one skilled in the art would understand a microprocessor to be an integrated circuit (IC). Accordingly, the microprocessor identity uniquely identifies the specific microprocessor. Further, the microprocessor identity does not change once assigned, as "the microprocessor identity is etched into the microprocessor."<sup>\*</sup>

In contrast, Cooper discloses a machine id, which is generated using "user-specific attributes" and a machine id generator "which is preferably a random number generator which receives a plurality of binary characters as an input, and generates a pseudo-random output which is representative of machine identification 357." Cooper, col. 14, ll. 42-45. Further, Cooper states that "the process employed by machine identification generator 355 is any conventional pseudo-random number generator which receives as an input of binary characters, and produces as an

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<sup>\*</sup>Once the microprocessor is etched into the microprocessor is cannot be changed.

output a plurality of pseudo-random binary characters, in accordance with a predefined algorithm.” Cooper, col. 14, ll. 45-50. From the above, it is clear that the machine id of Cooper: (i) is not constant (*i.e.*, it changes each time a new machine id is required) and (ii) does not uniquely identify the microprocessor (*i.e.*, the machine id at most only temporarily identifies the machine on which the software is to be executed). Accordingly, the machine id in Cooper is not equivalent to the microprocessor identity recited in the claims. Further, neither Jones nor Friedman teach that which Cooper lacks as evidenced by the Examiner admitting Jones does not teach or suggest a microprocessor identity (*see* Office Action mailed May 25, 2007, p. 4) and the Examiner’s reliance on Friedman only to teach the etching of a private key in memory located on a microprocessor (*see* Office Action mailed May 25, 2007, pp. 4-5).

***(ii) Jones and Cooper cannot be properly combined.***

It is a well established tenant of patent law that “[i]f [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)” M.P.E.P. § 2143.01 V. In the instant case, the Examiner has asserted that the invention of Jones may be modified using the teachings of Cooper. In particular, the Examiner asserts that Jones discloses “digital identity data” that is encrypted using a “random number.” *See* Office Action mailed May 25, 2007, pp. 3-4. The Examiner then relies on Cooper to teach a key derived from a machine id and asserts that one of ordinary skill in the art would use the security program of Cooper in the system of Jones. *See* Office Action mailed May 25, 2007, p. 3.

A review of Jones reveals that a different random number is generated each time the user’s password is to be validated. Jones, col. 8, ll. 4-41. Further, random numbers are used as part of the challenge-response mechanism employed by the system in Jones. Jones, col. 9, ll. 5-21. Thus, Jones requires a value that is not constant. In contrast, the machine id in Cooper is constant (*i.e.*, once established does not change). Cooper, col. 14, ll. 10-20. Moreover, Cooper relies on the unchanging nature of the machine id<sup>†</sup> to ensure that multiple computers cannot use the generated key (which is derived using the machine id) to run the software.

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<sup>†</sup> The machine id is constant for the duration of the license; however, it is not constant over the life of the machine.

Clearly, modifying Jones to replace the "random number" with a static value (*i.e.*, a machine id) would render the password validation scheme of Jones useless. Said another way, if the random number in Jones is replaced with a static value, then the challenge would be the same each time a user's password is verified and, accordingly, the resulting challenge-response mechanism would be easily circumvented as only one response would ever be required. Because the modification of Jones to include features of Cooper prevents the system of Jones from performing its intended purpose, there is no motivation to combine Jones and Cooper. In view of the above, claims 1, 6, 8, 9, and 69-72 are patentable over the cited prior art. Accordingly, withdrawal of this rejection is respectfully requested.

#### Claims 69 and 72

The Applicant reiterates that claims 69 and 72 recite "wherein the owner is a corporation, wherein the name is an incorporation name of the corporation, and wherein the digital identity data further comprises at least one selected from the group consisting of a date and place of incorporation of the corporation, a name of a corporate officer of the corporation, and a corporate partner of the corporation." Emphasis added. The Examiner has asserted that Friedman discloses an image of a corporate officer and then concluded that because the image includes the face of a corporate officer and the face is associated with a name, that the above limitation is taught. See Office Action mailed May 25, 2007, pp. 2-3.

At the outset, the Applicant is unaware of any teaching or suggestion in Friedman of an image of a corporate officer. At most, Friedman teaches the storage of images but fails to teach or suggest the storage of an image of a corporate officer. Moreover, even assuming *arguendo* that Friedman teaches the storage of an image of a corporate officer, there is no teaching or suggestion of storing a name of a corporate officer associated with the image. In fact, Friedman is completely silent with respect to annotating an image, for example, by including the name of the individual in an image. In view of the above, Friedman does not teach or suggest that storage of digital identity data, where the digital identity data is a name of a corporate officer. In view of the above, claims 69 and 72 are patentable over the cited prior art for this additional reason. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 34, 64, 73-75

Claims 34, 64, 73-75 stand rejected under 35 U.S.C. § 103 (a) as being obvious over Jones, Cooper, Friedman, U.S. Patent No. 6,567,915 ("Guthery"), U.S. Patent No. 6,111,506 ("Yap"), and U.S. Patent No. 6,847,948 ("Paolini"). Applicant asserts that the Examiner has failed to establish a *prima facie* case of obviousness for at least the following reasons.

With respect to claims 34 and 64, independent claim 34 includes at least the same digital identity device as recited in independent claim 1. As discussed above with respect to independent claim 1, Jones, Cooper, and Friedman, whether considered separately or in combination, fail to teach or suggest all the limitations of the digital identity device of independent claim 1. Thus, the aforementioned references also do not teach or suggest all the limitations of the digital identity device of independent claim 34. Further, Gurthey, Yap and Paolini do not teach or suggest that which the aforementioned prior art references lack. This is evidenced by the fact that Gurthey, Yap and Paolini are only used to teach or suggest:

obtaining digital identity data from a digital identity device operatively connected to a computer in which the electronic document is stored; encrypting the electronic document using the digital identity data. See Office Action mailed March 25, 2007, pp. 6-8.

In view of the above, all of the cited prior art references, whether viewed separately or in combination, fail to teach or suggest all the limitations of independent claim 34. Dependent claim 64 is patentable over all of the cited prior art references for at least the same reasons as independent claim 34.

Further, with respect to claim 73, at least the following explicit limitations are recited in claim 73: (i) a digital identity device including two separate memories; (ii) digital identity data stored in the first memory; and (iii) an operating system in the second memory binding the digital identity data and the microprocessor identity. The Examiner has asserted that the aforementioned limitations are disclosed in Figure 3 of Jones. See Office Action mailed May 25, 2007, p. 6. While Figure 3 shows two separate memories, Figure 3 does not teach or suggest where an operating system is located. Moreover, assuming *arguendo* that the operating system corresponds to software with functionality to "bind the digital identity data to the microprocessor identity...", then, as

previously asserted by the Examiner<sup>‡</sup>, this functionality is provided by item 325 in Figure 2. Item 325 is the point at which the random number (which the Examiner asserts may be replaced with a microprocessor id) is “encrypted” with the password (which the Examiner asserts is the digital identity data). A review of Jones reveals that item 325 is located in the smart card I.C. (250 in Figure 2). The smart card I.C., 250 in Figure 2, corresponds to the smart card I.C., 415 in Figure 3. Thus, based on this analysis, Figure 3 of Jones can be used to show, in direct opposition to the explicit language of the claim, a single memory that includes both the digital identity data and the “operating system.” In view of the above, Jones fails to teach or suggest the above limitations. Further, none of the cited references provides that which Jones lacks as evidenced by the fact that the Examiner only relied on Jones to teach this limitation. Accordingly, independent claim 73 is patentable over the cited prior art references.<sup>§</sup>


With respect to claim 74, claim 74 depends from independent claim 73 and, thus, is patentable for at least the same reasons as independent claim 73. With respect to claim 75, claim 75 depends from independent claim 73 and, thus, is patentable for at least the same reasons as independent claim 73. Further, dependent claim 75 is additionally patentable over the cited prior art for at least the same reasons as discussed above with respect to dependent claim 69. In view of the above, withdrawal of this rejection is respectfully requested.

### Conclusion

In view of the above, the Examiner has failed to establish a prima facie case of obviousness for any of the pending claims. Accordingly, a favorable decision from the panel is respectfully requested.

Dated: September 25, 2007

Respectfully submitted,

By 

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<sup>‡</sup> Office Action mailed May 25, 2007, p. 4.

<sup>§</sup> Applicant does not believe it is necessary to address the teachings of Guthery, Yap, and Paolini when addressing claim 73 as the aforementioned references were used to teach limitations only present in claim 34.